REMARKS

Examiner has rejected claims 1 through 7, 15 through 18 and 26 through 33 under 35 U.S.C. § 102.

Examiner has rejected claims 8 and 19 under 35 U.S.C. § 103.

Examiner has indicated claims 9 through 14 are objected to while containing allowable subject matter.

Examiner has indicated claims 20 through 25, 34 and 35 are allowable.

Rejection under 35 U.S.C. § 102(e)

Examiner has rejected claims 1 through 7, 15 through 18 and 26 through 33 under 35 U.S.C. § 102 (b) as being anticipated by USPN 5,596,712 (Tsuyama). Applicant has amended claim 18. Applicant respectfully traverses the rejections of claims 1 through 7, 15 through 17 and 26 through 33 and requests reconsideration.

Criteria for a Rejection under 35 U.S.C. § 102

The criteria for a rejection under 35 U.S.C. § 102 has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as

is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Below, Applicant points out subject matter within each independent claim that is not disclosed or suggested by Tsuyama. On the basis of this, Applicant believes the independent claims discussed below and all the claims dependent thereon are patentable over Tsuyama.

Discussion of Independent Claim 1

Claim 1 sets out an authoring tool that assists an author in building an automated diagnostic system for a product. The authoring tool includes three separate editor interfaces that allow an author to place information into three separate data structures.

Specifically, a cause editor interface allows an author to place, in a cause data structure, information pertaining to causes of malfunction of the product. An action editor interface allows an author to place, in an action data structure, information pertaining to actions that can be taken to correct malfunction of the product. A question editor interface allows an author to place, in a question data structure, information pertaining to questions that can be asked a user of the product to help identify causes of malfunction of the product.

Tsuyama does not disclose or suggest such an authoring tool that includes three separate editor interfaces that allow an author to place information into three separate data structures.

Examiner has made the following correlations of the elements of claim 1 to Tsuyama:

Cause editor interface: Tsuyama, column 2, lines 60-63; column 3, lines 17-21

Action editor interface: Tsuyama, column 3, lines 1-2;

Question editor interface: Tsuyama, column 3, lines 1 through 6:

In these sections of Tsuyama, only a single data structure is discussed. Specifically, a fault tree represents past causal relations between faults and causes thereof in a tree structure together with information concerning structure and characteristics of the product. See Tsuyama at column 2, lines 54 through 59.

Likewise, in these sections of Tsuyama, only a single interface is discussed for allowing a user to input information to the fault tree. Specifically, a terminal apparatus is set out that is capable of communicating with the computer for inputting new fault information of the product. See Tsuyama at column 2, lines 60 through 63. Other elements set out in this section (e.g., means responsive to the input; means for generating information; means for supplying information) appear to describe how the system handles information, and does not pertain to information entry to the system by a user.

Since Tsuyama describes only a single data structure and only a single interface for receiving data, it is clear that Tsuyama does not disclose or suggest an authoring tool that includes three separate editor interfaces that allow an author to place information into three separate data structures, as is set out by claim 1 of the present application.

Discussion of Independent Claim 26

Claim 26 sets out an authoring tool that assists an author in building an automated diagnostic system for a product. The authoring tool includes two separate editor interfaces that allow an author to place information into two separate data structures.

Specifically, a diagnostic system model editor interface allows the author to place in a diagnostic system model structure, information pertaining to malfunction of the product. A library module editor interface that allows the author to place in a library data structure information pertaining to modules corresponding with components of the product.

Tsuyama does not disclose or suggest such an authoring tool that includes two separate editor interfaces that allow an author to place information into three separate data structures.

Examiner has made the following correlations of the elements of claim 1 to Tsuyama:

Diagnostic system model editor interface: Tsuyama, column 2, lines 54-63'

Library Module editor interface: Tsuyama, column 13, lines 6-34;

In these sections of Tsuyama, only a single data structure is discussed. Specifically, a fault tree represents past causal relations between faults and causes thereof in a tree structure together with information concerning structure and characteristics of the product. See Tsuyama at column 2, lines 54 through 59.

Likewise, in these sections of Tsuyama, only a single interface is discussed for allowing a user to input information to the fault tree. Specifically, a terminal apparatus is set out that is capable of communicating with the computer for inputting new fault information of the product. See Tsuyama at column 2, lines 60 through 63. Other elements set out in this section (e.g., means responsive to the input; means for generating information; means for supplying information) appear to describe how the system handles information, and does not pertain to place information entry to the system by a user.

Column 13, lines 6 through 34 of Tsuyama discusses software for performing search and analysis. In column 13, lines 6 through 34, various software modules are discussed. However, column 13, lines 6 through 34 do not disclose or suggest a library module editor interface or any other type of interface that allows an author to place information into a library data structure or into any other type of data structure.

Since Tsuyama describes only a single data structure and only a single interface for receiving data, it is clear that Tsuyama does not disclose or suggest an authoring tool that includes two separate editor interfaces that allow an author to place information into two separate data structures, as is set out by claim 26 of the present application.

Rejection under 35 U.S.C. § 103(a)

Examiner has rejected claims 8 and 19 under 35 U.S.C. § 102 (a) as being unpatentable over Tsuyama in view of by USPN 4,965,742 (Skeirik).

Applicant believes claim 8 is allowable based on the allowability of underlying independent claim 1, discussed above.

Applicant has amended independent claim 18 to include a limitation formerly found in claim 19. Applicant therefore, discusses independent claim 18 below.

Criteria for a Rejection under 35 U.S.C. § 103

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there are claim limitations that are not taught or suggested by any of the cited references.

Discussion of Independent Claim 18

Applicant has amended claim 18 to include a limitation formerly found in claim 19. Claim 18 sets out an authoring tool that assists an author in building an automated diagnostic system for a product. The authoring tool comprises a cause editor interface that allows an author to place, in a cause data structure, information pertaining to causes of malfunction of the product. For a cause, the information relates to the following categories: name of the cause, parent of the cause, explanation of the cause, and probability of the cause being source of malfunction.

The information pertaining to the cause additionally relates to the following categories: dependency on environment in which the product is located. This is not disclosed or suggested by Tsuyama or Skeirik.

The specification, in Table 3, at page 19 gives an example of a cause being dependent on environment in which the product is located. Specifically, Table 3 indicates light print can be caused by environmental conditions such as humidity, temperature, etc.

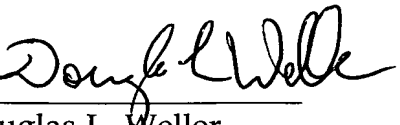
Information pertaining to the cause relating to dependency on environment in which the product is located is not disclosed or suggested by Tsuyama or Skeirik. Examiner has cited Skeirik at column 42, lines 37 through 54 for this feature. However, Skeirik at column 42, lines 37 through 54 is discussing computer access in multi-user environments. This is not related to causes of the malfunction of a product, as set out in claim 18 of the present case.

Conclusion

Applicant believes this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

CLAUS SKAANNING

By 
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